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Re:

Applicant : Edmonds Taylor Brian  
Serial No. : 09/763,994  
Filed : February 27, 2001  
For : Human Latent Transforming Growth  
Factor- $\beta$  Binding Protein 3  
Docket No. : X-12239

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Answers That Matter.

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**PATENT APPLICATION**  
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|            |                                    |   |                 |
|------------|------------------------------------|---|-----------------|
| Applicant  | : Edmonds Taylor Brian             | ) | Conf. No:       |
| Serial No. | : 09/763,994                       | ) | 6826            |
| Filed      | : February 27, 2001                | ) | Group Art Unit: |
|            |                                    | ) | 1647            |
| For        | : Human Latent Transforming Growth | ) | Examiner        |
|            | Factor- $\beta$ Binding Protein 3  | ) | Romeo, David S. |
| Docket No. | : X-12239                          | ) |                 |

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

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Claims 32-45 are currently pending. The Examiner has made a restriction requirement under 35 U.S.C. §121. Applicant provisionally elects with traverse Group I and the species SEQ ID NO:2. Applicant respectfully requests, however, that all sequences specified in Claim 32, which is part of Group I, be examined together. The sequences are presented as a Markush group and are so linked as to form a single inventive concept. Restricting out members of this group is improper. In addition, Applicant respectfully requests that Group III, which encompasses a method of using the compounds of Group I, be examined with Group I.

With respect to Group I, the Examiner has indicated that the claims are directed to more than one species of the generic invention, and therefore, lack unity of invention.

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Claim 32 encompasses an hLTBP-3 polypeptide which has at least 181 contiguous amino acids of a polypeptide selected from the group consisting of: SEQ ID NO:2, SEQ ID NO:4, and SEQ ID NO:6. These sequences all share the common structural feature of hLTBP-3 (SEQ ID NO:2). SEQ ID NO:4 is a fragment of hLTBP-3 (amino acids 1-188), and SEQ ID NO:6 represents a variant of hLTBP-3.

These polypeptides are claimed as a Markush group. Applicant respectfully asserts that it is not proper to restrict out members of a Markush group especially when the compounds included within the group share a common utility and a substantial structural feature. See MPEP §803.02.

In distinguishing restriction requirements made between different claims and those made in the context of a Markush group, the Federal Circuit noted that "it is never proper for an examiner to reject a Markush claim under 35 U.S.C §121. Section 121 simply does not authorize such a rejection." *In re Watkinson*, 900 F.2d 230, 232 (Fed. Cir. 1990). The MPEP §803.02 points out two specific cases where the Board of Appeals reversed an Examiner's decision to restrict out claims of a Markush group. See *In re Weber*, 580 F.2d 455 (C.C.P.A. 1978); *In re Haas*, 580 F.2d 461 (C.C.P.A. 1978). In *Weber*, the court stated that "an applicant has a right to have each claim examined on the merits" and noted that if a single claim is required to be divided up, that claim would never be considered on its merits. 580 F.2d at 458. The court held that while section 121 allows the restriction of independent and distinctive inventions, "[i]t does not...provide a basis for an examiner acting under the authority of the Commissioner to reject a particular claim on that basis." *Id.*

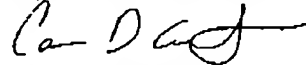
Thus, it is improper to restrict SEQ ID NO:2, SEQ ID NO:4 and SEQ ID NO:6 into three groups. This requirement would prevent Applicant from ever having the claim as filed considered on the merits. Applicant respectfully requests that this requirement for restriction be reconsidered.

The non-elected claims of Group III (claims 40 and 43) are drawn to a method for inhibiting or stimulating tissue growth comprising administering to a patient in need thereof a polypeptide of the present invention. According to MPEP §821.04, an Applicant is entitled to have non-elected claims drawn to a method of using a composition rejoined once composition of matter claims drawn to the same composition have been allowed. If the Examiner does not examine Group III along with the claims of Group I, Applicant will request rejoinder of the non-elected claims of Group III once Claims 32-36, and 38 have been found to be in condition for allowance.

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The Applicant urges the Examiner to call the Applicant's attorney at (317) 651-4215 if a telephone conversation would be helpful in expediting prosecution of this case.

Respectfully submitted,



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